

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Takahisa Ueda et al

Appln. No. : 09/270,673

Filed : March 16, 1999

For : ANNULAR SLIDING FLUORO-
PLASTICS MEMBER, AND A
METHOD OF PRODUCING AN
ANNULAR SLIDING FLUORO-
PLASTICS MEMBER



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) Art Unit: 1772

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) Ex: M. Miggins
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RESPONSE

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

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In response to the Office Action of September 12, 2000, applicants provisionally elect claims 1-12 for further prosecution in this application.

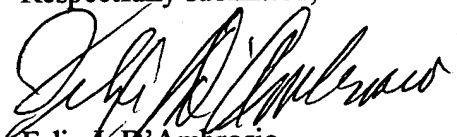
This election is respectfully traversed.

The election is based on the examiner's contention that claims 1-12 define a distinct invention from that defined in claims 13-21. To support his distinct argument, the examiner follows the two point test of: "(1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process...." The examiner concludes that (1) applies, i.e., that "[i]n the instant case invention II could be used to make a pipe."

Applicants have difficulty with this conclusion because there is nothing in the application to support it. Perhaps the method can be used to make a different product and perhaps not. The point is that one should not speculate but instead refer to the specification. If the specification makes it clear that another product (than that claimed) can be made, then the examiner is justified in his restriction requirement. If the converse is true, that is, that the specification does not make this point clear, then a restriction requirement is not proper.

Applicants are of the opinion that the later applies so that restriction here is not proper.

Respectfully submitted,



Felix J. D'Ambrosio
Reg. No. 25,721

October 12, 2000

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